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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/024,333  
Filing Date: December 21, 2001  
Appellant(s): RUBINSTENN ET AL.

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Anthony M. Gutowski  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed September 1, 2009 appealing from the Office action mailed April 10, 2009.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,081,611

LINFORD ET AL.

6-2000

Rodan & Fields Proactiv Solution, February 12, 2001; April 11, 2001; June 17, 2001;

<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>;

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<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>;

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>;

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>;

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 31 – 36, 38 – 45, and 47** are rejected under 35 U.S.C. 102(b) as being anticipated by **Linford et al. (US Patent 6,081,611)**.

3. In regards to **claim 31**, **Linford** discloses a system for enabling determination of prognosis for an external body condition of a subject, the system comprising:

a memory for receiving at least one representation of the subject's external body condition (**Col. 5 Lines 30 – 57**);

a database for storing information on how use of at least one beauty product affects evolution of the external body condition (**Col. 5 Lines 30 – 57**);

a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product (**Col. 5 Lines 30 – 57**); and

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a driver for outputting the prognosis to enable the subject to receive the prognosis  
**(Col. 5 Lines 30 – 57).**

4. In regards to **claim 32**, **Linford** discloses a system for enabling determination of a prognosis for an external body condition of a subject, the system comprising:

means for receiving at least one representation of the subject's external body condition **(Col. 5 Lines 30 – 57);**

means for maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition **(Col. 5 Lines 30 – 57);**

means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product **(Col. 5 Lines 30 – 57; Col. 1 Lines 43 – 47);** and

means for outputting the prognosis to enable the subject to receive the prognosis **(Col. 5 Lines 30 – 57).**

5. In regards to **claim 33**, **Linford** discloses further comprising means for enabling the subject to receive instructions relating to obtaining of the representation **(Col. 5 Lines 54 – 57).**

6. In regards to **claim 34**, **Linford** discloses wherein the instructions comprise instructions relating to capturing of an image with an image capture device chosen from a web cam, a digital camera, and a scanner **(Col. 6 – 8 Lines 66 – 30).**

7. In regards to **claim 35** **Linford** discloses further comprising means for constructing a representative image, wherein said means for generating the prognosis

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compares the constructed image to the information in the database **(Col. 7 – 8 Lines 48 – 42; and wherein it is inherently included that the manipulation of the image is accomplished based on the programming parameters, such as removing wrinkles [see for example Col. 24 – 25 Lines 67 – 2])**.

8. In regards to **claim 36, Linford** discloses wherein the representation comprises at least one image representative image of the external body condition, wherein the information in the database comprises image morphing information, wherein said means for generating the prognosis comprises means for morphing the representative image based on the image morphing information **(Col. 20 – 21 Lines 64 – 3)**.

9. In regards to **claim 38, Linford** discloses wherein the representation is stored in a data storage device, and wherein said means for receiving the representation comprises means for receiving the data storage device **(Col. 1 Lines 30 – 36)**.

10. In regards to **claims 39, 41, and 45, Linford** discloses wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing beauty products **(The Examiner asserts that the fact that the subsets of information relate to differing beauty products does not affect how the system works. That is to say, the system is capable of performing various manipulations based on the type of skin imperfection. It is inherent that the system would treat the manipulation process differently depending on the type of skin condition. [See also Col. 25 Lines 19 – 23])**.

11. In regards to **claims 40, 42, and 44, Linford** discloses wherein the means for outputting further comprises means for outputting product information to enable the

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subject to be informed about a beauty product relating to the information in the database used to generate the prognosis (**Col. 1 Lines 30 – 57, wherein the system is capable of displaying information pertaining to a beauty product with the provided monitor**).

12. In regards to **claim 43**, the Examiner asserts that wherein the manners of using differ from one another according to at least one of timing of product usage, the length of time while the product is used, the frequency of use of the product, the length of time between each use of the project, the manner in which the product is applied, an applicator device used to apply the product, and the manner of using the applicator device does not affect how the system performs the function of manipulating a photo in order to provide a customer with a predicted result of a cosmetic procedure.

13. In regards to **claim 47**, **Linford** discloses a system for enabling determination of a prognosis for an external body condition of a subject, the system comprising:

a memory for receiving at least one image representative image of the subject's external body condition (**Col. 5 Lines 30 – 57**);

a secondary storage storing a mesh frame representative of at least one part of human anatomy (**Col. 5 Lines 30 – 57**);

a database containing information on how use of at least one beauty product affects evolution of the external body condition (**Col. 5 Lines 30 – 57**);

a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of

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the at least one beauty product (**Col. 5 Lines 30 – 57; Col. 18 Lines 41 – 52; Col. 25 Lines 25 – 27**); and

a driver for outputting the prognosis image to enable the subject to view the prognosis image (**Col. 5 Lines 30 – 57**).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 1 – 30, 37, 46, and 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Linford et al. (US Patent 6,081,611)** in view of **Proactiv ([http://web.archive.org/web/20010521145551rn\\_1/www.proactiv.com/index.php](http://web.archive.org/web/20010521145551rn_1/www.proactiv.com/index.php))**.

16. In regards to **claims 1 and 48**, **Linford** discloses a computer-implemented method for enabling determination of a prognosis for an external body condition of a subject, the method comprising:

receiving, in a memory, at least one representation of the subject's external body condition (**Col. 1 Lines 35 – 38**);

generating, using a processor, based on both the received representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product (**Col. 1 Lines 43 – 47**); and



outputting, to a device, the prognosis to enable the subject to receive the prognosis (**Col. 1 Lines 43 – 47**).

**Linford** discloses a method and system where a patient provides a pre-operative digital image, such as images pertaining to wrinkles or skin imperfections (**Col. 25 Lines 19 – 23**), and where the image is then manipulated to provide predicted changes based on a cosmetic surgical procedure as well as the information that is provided during a consultation so that a patient is able to view the after effects of a cosmetic procedure.

**Linford**, however, fails to disclose:

maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition.

However, **Proactiv** discloses how the use of a beauty product affects the evolution of an external body condition, wherein the information is stored in a database.

**Proactiv** discloses how the use of their different products and how the use of various chemicals affect the treatment process

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>, <http://web.archive.org/web/20010411110141/www.proactiv.com/how/how.php>).

As a result, it would have been obvious to look upon the teachings of **Proactiv**, which

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stores additional information regarding a beauty product to show predictable outcomes, and to combine it with the teachings of **Linford** where information is stored within a database to produce a predictable outcome. It would have been well within the ability of one having ordinary skill in the art to use the additional information provided by a beauty product, such as a wrinkle remover, in order to better provide a more accurate predictable outcome of a patient.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Linford** in view of the teachings of **Proactiv** to provide a database containing information of how the use of a beauty product affects the evolution of an external body condition and to better inform a patient of the benefits and limitations of the procedure.

17. In regards to **claims 2 – 3**, **Linford** discloses wherein the at least one representation defines the external body condition (**Col. 1 Lines 35 – 38; wherein it is obvious that the image is defining a condition since it is a pre-operative image**).

18. In regards to **claim 4**, **Linford** discloses, wherein the prognosis comprises a prognosis image (**Col. 1 Lines 42 – 48**).

19. In regards to **claim 5**, **Linford** discloses wherein the prognosis image comprises a three-dimension prognosis image (**Col. 18 Lines 41 – 42; Col. 25 Lines 25 – 27**).

20. In regards to **claim 6**, **Linford** discloses further comprising transmitting to the subject instructions relating to obtaining of the representation (**Col. 7 – 8 Lines 48 – 42**).

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21. In regards to **claim 7**, **Linford** discloses wherein the instructions comprise instructions relating to capturing of an image with an image capture device chosen from a web cam, a digital camera, and a scanner **(Col. 7 – 8 Lines 48 – 42)**.

22. In regards to **claims 8**, **Linford** discloses further comprising constructing, using a processor, an image based on the representation, wherein said generating of the prognosis comprises comparing the constructed image to the information in the database **(Col. 7 – 8 Lines 48 – 42; and wherein it is obviously included that the manipulation of the image is accomplished based on the programming parameters, such as removing wrinkles [see for example Col. 24 – 25 Lines 67 – 2])**.

23. In regards to **claim 9**, **Linford** discloses wherein the wherein the information in the database comprises image morphing information, and wherein said generating of the prognosis comprises morphing the representative image based on the image morphing information **(Col. 20 – 21 Lines 62 – 3)**.

24. In regards to **claims 10 and 37**, **Linford** discloses wherein the representation is received via a network, and wherein the subject is located at a location remote from a location where the database is maintained **(Col. 5 Lines 54 – 57 wherein it would have been obvious for one of ordinary skill in the art that an image can be sent through e-mail)**.

25. In regards to **claim 11**, **Linford** discloses wherein the representation is stored in a data storage device **(Col. 5 Lines 30 – 36)**.

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26. In regards to **claim 12**, **Proactiv** discloses wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing beauty products

(<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>).

27. In regards to **claim 13**, **Proactiv** discloses wherein the outputting further comprises outputting product information to enable the subject to be informed about a beauty product relating to the information in the database used to generate the prognosis

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>).

28. In regards to **claim 14**, **Proactiv** discloses wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing manners of using a beauty product

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>).

29. In regards to **claim 15**, **Proactiv** discloses wherein the outputting further comprises outputting usage information to enable the subject to be informed about the manner of beauty product usage relating to the information in the database used to generate the prognosis

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>, <http://web.archive.org/web/20010411110141/www.proactiv.com/how/how.php>).

30. In regards to **claim 16**, **Proactiv** discloses wherein the manners of using differ from one another according to at least one of timing of product usage, the length of time while the product is used, frequency of use of the product, the length of time between each use of the product, the manner in which the product is applied, an applicator device used to apply the product, and the manner of using the applicator device

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>, <http://web.archive.org/web/20010411110141/www.proactiv.com/how/how.php>).

31. In regards to **claims 17 – 19**, although the **combination of Linford and Proactiv** fails discloses wherein the beauty product is chosen from skin products, hair products, and nail products, moisturizers, wrinkle removers, and hair product chosen from a conditioner and a shampoo the Examiner asserts that it would have been obvious to one having ordinary skill in the art that a variety of beauty products can be

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used and all would produce the same predictable result of generating a prognosis showing the effects of using a beauty product.

32. In regards to **claim 20**, **Proactiv** discloses further comprising outputting product purchase information enabling the subject to purchase the beauty product relating to the information in the database used to generate the prognosis

**([http://web.archive.org/web/20010521145551rn\\_1/www.proactiv.com/index.php](http://web.archive.org/web/20010521145551rn_1/www.proactiv.com/index.php)).**

33. In regards to **claim 21**, **Linford** discloses wherein the generating the prognosis comprises comparing the representation with information in the database and selecting a portion of the information in the database based on the comparing **(Linford discloses that a variety of morphing features can be used to create a prognosis depending on the procedure the customer needs/wants, such as wrinkles or other skin imperfections. See also Col. 25 Lines 19 – 23).**

34. In regards to **claims 22 and 46**, **Linford** discloses wherein the outputting the prognosis comprises transmitting the prognosis to a device via a network **(Col. 5 Lines 53 – 57 and wherein it would have been obvious that if a teleconferencing session is used the images can be transmitted via e-mail, for example).**

35. In regards to **claim 23**, **Proactiv** discloses wherein the at least one beauty product is selected from a plurality of differing beauty products, and wherein the method further comprises receiving a selection of the at least one beauty product

**(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,**

**<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,**

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<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>, <http://web.archive.org/web/20010411110141/www.proactiv.com/how/how.php>).

36. In regards to **claim 24**, **Proactiv** discloses further comprising enabling the subject to make the selection of the at least one beauty product from the plurality of beauty products

(<http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php>,

<http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php>,

<http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php>,

<http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php>, <http://web.archive.org/web/20010411110141/www.proactiv.com/how/how.php>).

37. In regards to **claim 25**, **Linford** discloses further comprising rendering the prognosis on a three-dimensional mesh image (**Col. 18 Lines 41 – 52; Col. 25 Lines 25 – 27**).

38. In regards to **claim 26**, **Linford** discloses further comprising generating a mathematical model corresponding to a three-dimensional image resulting from the rendering of the prognosis on the three-dimensional mesh image (**Col. 18 Lines 41 – 52; Col. 25 Lines 25 – 27 and wherein it is obviously included that a mathematical model must be used in order to properly carry out the manipulation.**).

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39. In regards to **claim 27**, **Linford** discloses further comprising enabling modification of the representative image based on an input by the subject (**Col. 4 Lines 5 – 14**).

40. In regards to **claim 28**, **Linford** discloses wherein the input by the subject further comprises at least one of the addition and removal of wrinkles from the representative image (**Col. 25 Lines 19 – 23**).

41. In regards to **claim 29**, **Linford** discloses wherein said at least one of the addition and removal of wrinkles comprises modifying at least one parameter associated with a mathematical model corresponding to the image (**obviously included**).

42. In regards to **claim 30**, **Linford** discloses wherein generating at least one prognosis comprises modifying at least one parameter associated with the mathematical model (**obviously included**).

#### **(10) Response to Argument**

##### **Rejection under 35 USC 102**

##### **Claims 31, 32, and 47**

43. In response to appellant's argument that **Linford** fails to disclose a, "database" or any component for storing information on how use of at least one beauty product affects evolution of an external body condition, as well as, a "processor for modifying [a] representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product", a recitation of the intended use of the claimed



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invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

However, the Examiner asserts that **claims 31, 32, and 47**, discloses a system, which utilizes stored data to allow the user to manipulate an image for enabling a determination of prognosis for an external body condition of a subject. Consequently, it is asserted that in order for the physician to manipulate the provided images, as disclosed by **Linford**, data pertaining to the type of manipulation must be stored within **Linford's** system, since it is necessary information required by the system to allow for the manipulation. In other words, the Examiner asserts that in order for the user to manipulate the image to the desired outcome, the system must require data/information that instructs the system on how to carry out or perform the manipulation desired by the user.

Moreover, the Examiner further asserts that a database is nothing more than a file composed of information wherein the information contains fields together with a set of operations for searching, sorting, recombining, and other functions. In other words, a database is nothing more than an organized body of related information/data and although the database may be stored on a tangible computer-readable medium it does not imply that the database is a tangible computer-readable medium. That is to say, a database is considered to be data not structure.

Further still, the Examiner also notes that the claim recites:

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“a database for storing information on how use of at least one beauty product affects evolution of the external body condition;

a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product;”

Specifically, the Examiner notes that the information that the processor is using does not necessarily have to be the information pertaining to the use of a beauty product. As claimed, the Examiner asserts that the database contains two pieces of information:

the first being information the effects of using a beauty product, and

the second being some type of other information that is stored in the database to allow for the generation of the modified representation.

That is to say, the claims do not recite:

a processor for modifying the representation, based on the information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.

As a result, even if one were to continue to argue that the information that is being used by the processor in **Linford** is not information pertaining to the effects of using a beauty product it is asserted by the Examiner that the information that the processor is using in the claims does not necessarily limit it to only information pertaining to the effects of using a beauty product, but any other information that may be stored in the database.

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As a result, the rejection is maintained since it is asserted that **Linford's** system is fully capable of storing a database containing information on how the use of a beauty product affects the evolution of an external body condition. With that said, it is further asserted that **Linford** also discloses a system having a processor that is capable of modifying the representation of a subject (data) based on information contained in the database in order to generate a prognosis reflecting predicted changes after using the beauty product.

44. Regarding **claim 47**, the appellant argues that **Linford** fails to disclose:

"a secondary storage storing a mesh frame representative of at least one part of human anatomy."

Again, the appellant is arguing the intended use of the storage medium, i.e. the type of data that is being stored on the secondary storage. However, as discussed above, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As discussed in the rejection, **Linford** does, indeed, disclose two storage mediums that are fully capable of storing a mesh frame representative of at least one part of human anatomy and information on how using a beauty product affects the evolution of an external body condition.

**Claims 33 – 38 – 45**

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45. All rejections made toward dependent **claims 33 – 36 and 38 – 45** are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are patentable over **Linford**.

### **Rejection under 35 USC 103**

#### **Claims 1 and 48**

46. The appellant argues that the **combination of Linford and Proactiv** fails to teach or disclose:

“maintaining, in a database, information on how use of at least one beauty product affects evolution of an external body condition;  
generating, based on both the received representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.”

However, the Examiner respectfully disagrees.

As discussed above, **Linford** discloses that two pieces of information are used for providing the predicted prognosis. **Linford** discloses using the patient's pre-operative image as well as the information that was provided during the patient consultation. Further still, as previously discussed in the Final Office Action, one of ordinary skill in the art would have recognized that in order to perform the prognosis the computer system must use information used in the database, such as, **but not limited**

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to, program information to allow for the manipulation of the received representation and consultation information. As discussed above, the claims have failed to set forth that the information that is being used for the manipulation process is only limited to information on how use of at least one beauty product affects evolution of [an] external body condition. To be more specific, the claims disclose:

“generating, using a processor, based on both the received representation and information contained in the database...”

Regardless, the Examiner has provided **Proactiv** to disclose that it is old and well known to provided information on at least one beauty product and its evolutionary effects of an external body condition. It is further asserted that this information is obviously, if not inherently, stored in a database on a server in order to allow users to access to the information over the Internet. The appellant argues that **Proactiv** fails to disclose a database, but has failed to provide any evidentiary support to indicate how else the disclosed information is being stored or accessed by the user, i.e. the appellant has failed to provide any support that the information is not obviously being stored in a database.

Despite of this, the Examiner has provided rationale to indicate that one of ordinary skill in the art would have found it obvious that the **combination of Linford and Proactiv** does, indeed, disclose the storage and receiving of a representation of a subject's external body condition, generating a prognosis based on the original photo (representation) and using information stored within the system, such as, but not limited to, program information for the manipulation of the representation, consultation

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information, and/or information on at least one beauty product, as discussed in

**Proactiv**, in order to arrive at a prognosis to indicate how the use of a beauty product affects the evolution of an external body condition, in this case acne.

Moreover, one of ordinary skill in the art would have found it obvious that **Proactiv** teaches a known technique of including information on at least one beauty product and how the beauty product(s) affects the evolution of an external body condition. This known technique is applicable to the system and method of **Linford** as they both share characteristics and capabilities, namely, the generation of at least one prognosis reflecting predicted changes in the external body condition after use of at least one beauty product.

One of ordinary skill in the art would have recognized that applying the technique of **Proactiv** to the teachings of **Linford** would have yielded predictable results because the level of ordinary skill in the art demonstrated by the reference applied shows the ability to incorporate such data processing features into similar systems. Further still, the **combination** would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow more detailed prognosis according to the specific information about the beauty product and its affects.

Additionally, one of ordinary skill in art would have also found it obvious that the known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces since, as discussed above, the variations would have been predictable to one of ordinary skill in the art, are in the same field of endeavor, and would have prompted adaptations of

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the system based on the type of prognosis (which is based on the condition and external body condition).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Appellants submit that the function of a website is presenting a web page, and the function of an image editing tool based on a user input is editing an image in response to an input from a user. Without changing their respective functions, the web page, maintained in the website of Proactiv, cannot function as a user input, in the image editing tool of Linford, to "generat[e]...at least one prognosis reflecting predicted changes in [an] external body condition after use of...at least one beauty product," as recited in claim 1" {Page 24 – 25 last paragraph} To be more specific, the only received information (user input) disclosed in the claims is the representation of the subject's external body condition.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Claims 2 – 30**

47. All rejections made toward dependent **claims 2 – 30** are maintained due to the lack of a reply by the applicant in regards to distinctly and specifically point out the supposed errors in the examiner's action in the prior Office Action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be

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allowable because the independent claims are patentable over **Linford** in view of **Proactiv**.

### **Hindsight Arguments (17 – 19 )**

48. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Additionally, and as discussed above, the Examiner has provided sufficient rationale of why one of ordinary skill in the art would have found it obvious that the **combination of Linford and Proactiv** discloses the claimed invention.

### **Claim 25**

49. Appellant argues that the **combination of Linford and Proactiv** fails to disclose, "rendering a prognosis on a three-dimensional mesh image." However, as discussed above, **Linford** discloses using three-dimensional images for creating the prognosis of the individual. The Examiner asserts that the method in which the three-dimensional imaging is being claimed would have been old and well known to one of ordinary skill in the art and that one having ordinary skill would have further realized that there are various methods of creating a three-dimensional image. Moreover, the Examiner also asserts that both **Linford** and the appellant both arrive at the same conclusive result in



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that both **Linford** and the appellant generate a prognosis of an individual using a three-dimensional representation of the individual and the stored information. The appellant's arguments do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The Examiner asserts that the appellant has not clearly pointed out the advantages of using a three-dimensional mesh image over what is already known in the art and how one of ordinary skill in the art would have found it difficult or uniquely challenging in realizing the various advantages and disadvantages that the various methods provides. In other words, depending on the type of rendering required one of ordinary skill in the art would have realized which type of three-dimensional imaging technique would have provided the best results for providing a prognosis of an individual.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Gerardo Araque Jr.

/Gerardo Araque Jr./

Examiner, Art Unit 3689

December 2, 2009

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